

OCT 03 2005

SCHERING-PLOUGH CORPORATION
LAW DEPARTMENT
2000 GALLOPING HILL ROAD
K-6-1, MAIL STOP 1990
KENILWORTH, NEW JERSEY 07033
(908) 298-4000

FACSIMILE TRANSMITTAL SHEET

TO: Examiner: A. Freistein
USPTO
Mailstop: Amendment
FAX NUMBER:
(571) 273-8300

FROM: Palaiyur S. Kalyanaraman
PHONE NUMBER:
(908) 298-5068

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14
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October 3, 2005

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NOTES/COMMENTS:

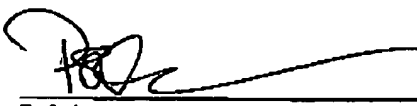
PLEASE HAND DELIVER

In re Application of: T. Guzi *et al.*
For Patent entitled: "17- β -Hydroxysteroid Dehydrogenase Type 3 Inhibitors for the Treatment of Androgen Dependent Diseases"
Group Art Unit: 1626
Filed: 12/15/2003
Attorney Docket No.: OC06001-01
Serial No.: 10/735,983

Dear Examiner Freistein,

Transmitted herewith are:

- > Fax Cover Sheet - 1pg.
- > Response Transmittal - 1pg.
- > Response/Amendment - 12pgs.


Palaiyur S. Kalyanaraman
Registered Representative
Registration No. 34,634

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PHONE: (908) 298-5068

FAX: (908) 298-5388

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/735983	
	Filing Date	12/15/2003	
	First Named Inventor	GUZI, Timothy J.	
	Art Unit	1626	
	Examiner Name	A. Freistein	
Total Number of Pages in This Submission	14	Attorney Docket Number	OC06001-01

ENCLOSURES (Check all that apply)		
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Remarks		

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Date	10/03/2005

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OCT 03 2005

PATENT: OC06001-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

T. Guzi et al.

Serial No.: 10/735,983

Filed: December 15, 2003

For: "17- β -Hydroxysteroid Dehydrogenase
Type 3 Inhibitors For The Treatment of
Androgen Dependent Diseases"

Examiner: A. Freistein

Group Art Unit: 1626

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mailstop: Amendment

RESPONSE/AMENDMENT

Sir:

This communication is in response to the Official Action dated September 19, 2005, on the subject patent application. This communication is being faxed to the Examiner's attention at 571-273-8300.

Claims 1-41 are pending in the case. The Examiner restricted the invention into two groups:

Group I: Claims 1-25 and 39-41 drawn to products of formula (I); and

Group II: Claims 26-38

If electing from among Groups I-II, the Examiner additionally required the election of a single disclosed species for prosecution on the merits.

Applicants believe that all claims 1-41 form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-41 as filed would not cause undue burden. Applicants

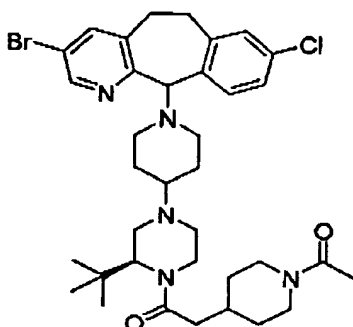
- 2 -

Under the statute "two or more independent and distinct inventions.... In one application may.... be restricted to one of the inventions." Inventions are "Independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

During A telephone conversation with the examiner on September 9, 2005, the undersigned attorney-of-record elected, with traverse, the invention cited as Group I for prosecution on the merits, and elected the following species:



again with traverse. *(The Office Action indicates the elected species with a mistake on page 9, with an -NH on the bottom ring of the elected compound instead of -N-C(O)CH₃. Appropriate correction is respectfully requested. Additionally, the Office Action indicates the scope of the elected species with a mistake on page 11, omitting an alkyl group between G and R at the bottom;*

- 3 -

)see the elected compound's structure above. Appropriate correction is respectfully requested here too.) This Response affirms that election (as corrected above). Applicants also agree with the scope of the elected invention as narrated by the Examiner on page 11 of the Office Action with the correction noted above.

Applicants respectfully request entry of the following Amendment made in accordance with the election.

Amendments to the Claims are reflected in the listing of claims which begins on page 4 of this paper.

Remarks begin on page 12 of this paper.